IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

CIVIL ACTIONS NO. 86-3374 and NO. 90-2430

OGONTZ CORPORATION,
Counterclaimant,

v.

FRED L. PIRKLE and THERM-OMEGA-TECH, INC.,
Counterclaim Defendants.

COUNTERCLAIM DEFENDANTS'
PROPOSED JURY INSTRUCTIONS

[FILED APRIL 4, 1994]

Pursuant to Rule 51 of the Federal Rules of Civil Procedure and Local Rule 21(d)4(a), Counterclaim Defendants respectfully submit these jury instructions and request that the Court charge the jury in accordance with the attached. Counterclaim Defendants reserve the right to supplement these requests to address issues which could not reasonably have been anticipated prior to trial.

Respectfully submitted,

/s/ Victoria E. Silbey
THOMAS B. KENWORTHY
Identification No. 18418
VICTORIA E. SILBEY
Identification No. 64345
Morgan, Lewis & Bockius
2000 One Logan Square
Philadelphia, PA 19103
(215) 963-5702/5667

Attorneys for Counterclaim
Defendants

COUNTERCLAIM DEFENDANTS'
PROPOSED JURY INSTRUCTION NO. 19

Importance Of Claim Construction

The first step to be addressed when deciding patent infringement is claim construction. This is a vitally important step and must not be given "short shrift."[1] Indeed, "improper claim construction can distort [an] entire infringement analysis."[2]

In the interpretation of words used in a patent claim, you should give consideration and weight to several pertinent factual issues, incuding the description of the claimed element in the specification, the intended meaning and usage of the claim terms by the inventor, what transpired during the prosecution of the patent applications, and the technological evidence offered by the expert witnesses.[3] You should also take into consideration the prior art because a patent claim must be construed to be limited so as to exclude prior art.[4]

You are advised, however, that a patent claim is not to be construed in light of the accused device. Indeed, "[i]t is only after the claims have been construed without reference to the accused device that the claims, as so construed, are applied to the accused device to determine infringement" (emphasis in original).

Authority: [1] Lemelson v. General Mills, Inc., 968 F.2d 1202, 1206 (Fed. Cir. 1992), cert. denied, 113 S. Ct. 976 (1993).

[2] SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 885 (Fed. Cir. 1988).

[3] Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft, 945 F.2d 1546, 1550 (Fed. Cir. 1991).

[4] Keller v. Clark Equipment Co., 210 U.S.P.Q. 742 (D.N.D. 1981).

[5] SRI Intern'l v. Matsushita Electric Corp. of America, 775 F.2d 1107, 1118 (Fed. Cir. 1985).

COUNTERCLAIM DEFENDANTS
PROPOSED JURY INSTRUCTION NO. 20

Claims Must Be Construed
In The Same Way On Issues
Of Infringement And Validity

The claims of a patent must be given the same construction when considering infringement as when considering validity.

Authority: Intervet America, Inc. v. Kee-Vet Laboratories, Inc., 887 F.2d 1050, 1053 (Fed. Cir. 1989).

COUNTERCLAIM DEFENDANTS'
PROPOSED JURY INSTRUCTION NO. 21

Additional Principles Of Patent
Law Pertinent To Claim Construction

In construing the '007 and '512 patents you should also consider the following principles of patent law.

Inventors are required to define their inventions with such particularity that would-be infringers know the metes

and bounds of the legal protection to which the patent owner is entitled.[1] In order to satisfy the enablement requirement for patentability, "there must be sufficient disclosure, either through illustrative examples or terminology, to teach those of ordinary skill how to make and how to use the invention as broadly as it is claimed."[2] The Patent and Trademark Office's grant of the '007 and '512 patents presumptively establishes that the statutory enablement requirement has been met. Mindful that the claims of a patent should be construed so as to maintain the validity of the patent if that is at all possible,[3] you should construe the claims of the '007 and '512 patents no more broadly than to encompass that which those of ordinary skill would have been enabled to make by the disclosure of those patents.

Authority: 1 Palmer v. United States, 423 F.2d 316, 319 (Ct. Cl.), cert. denied, 400 U.S. 951 (1970).

[2] In re Vaeck, 947 F.2d 488, 496 (Fed. Cir. 1991).

[3] ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577 (Fed. Cir. 1984).

COUNTERCLAIM DEFENDANTS' PROPOSED JURY INSTRUCTION NO. 22

Inventor To Be His Own Lexicographer

In instructing you on the issue of claim construction, I have advised you that you are to take into consideration the intended meaning and usage of the claim terms by the inventor. Inventors are not confined to normal dictionary meanings because the dictionary does not, and cannot, keep abreast of the inventor. Things are not made for the

sake of words, but words for things. To overcome this lag, patent law allows the inventor to be his own lexicographer (dictionary writer).[1] Though inventors may be their own lexicographers, they must use words in the same way in the claims and in the specifications.[2] Thus, the inventor's words must be construed in connection with the other parts of the patent instrument and with the circumstances surrounding the inception of the patent application.

Authority: [1] Fromson v. Advance Offset Plate, Inc., 720 F.2d 1565, 1569 (Fed. Cir. 1983).

[2] Fonar Corp. v. Johnson & Johnson, 821 F.2d 627, 632 (Fed. Cir. 1987), cert. denied, 484 U.S. 1027 (1988).

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

CIVIL ACTIONS NO. 86-3374 and NO. 90-2430

OGONTZ CORPORATION,
Counterclaimant,

v.

FRED L. PIRKLE and THERM-OMEGA-TECH, INC.,
Counterclaim Defendants.

COUNTERCLAIM DEFENDANTS' PROPOSED SUPPLEMENTAL JURY INSTRUCTIONS

[FILED APRIL 25, 1994]

Pursuant to Rule 51 of the Federal Rules of Civil Procedure and Local Rule 21(d)4(a), Counterclaim Defendants respectfully submit these supplemental jury instructions and request that the Court charge the jury in accordance with the attached. Counterclaim Defendants reserve the right to supplement these requests to address issues which could not reasonably have been anticipated prior to trial.

Respectfully submitted,

/s/ Thomas B. Kenworthy
THOMAS B. KENWORTHY
Identification No. 18418
VICTORIA E. SILBEY
Identification No. 64345
Morgan, Lewis & Bockius
2000 One Logan Square
Philadelphia, PA 19103
(215) 963-5702/5667

Attorneys for Counterclaim
Defendants

COUNTERCLAIM DEFENDANTS'
PROPOSED JURY INSTRUCTION NO. 35[1]

Claim Construction -- Language Construed As By One Skilled In the Art At The Time Of The Invention

"The claims of a patent should be construed as they would have been understood by one of ordinary skill in the art at the time the invention was made."

Authority: Mobil Oil Corp. v. Amoco Chemicals Corp., 779 F. Supp. 1429, 1442 (D.Del. 1991), aff'd, 980 F.2d 742 (1992); 865 F.2d 1247, 1251 (Fed. Cir. 1989).

---

1 Counterclaim defendants request that this instruction be added to Counterclaim Defendants' Proposed Jury Instruction Number 19.

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

CIVIL ACTIONS NO. 86-3374 and NO. 90-2430

OGONTZ CORPORATION,
Counterclaimant,

v.

FRED L. PIRKLE and THERM-OMEGA-TECH, INC.,
Counterclaim Defendants.

COUNTERCLAIM DEFENDANTS' PROPOSED
GENERAL VERDICT WITH INTERROGATORIES

[FILED APRIL 4, 1994]

Pursuant to Federal Rule of Civil Procedure 49(b), Counterclaim Defendants submit the attached general verdict form with interrogatories and request that the Court submit the form to the jury in accordance therewith. Counterclaim Defendants reserve the right to supplement these requests to address issues which could not reasonably have been anticipated prior to trial.

Respectfully submitted,

/s/ Victoria E. Silbey
THOMAS B. KENWORTHY
Identification No. 18418
VICTORIA E. SILBEY
Identification No. 64345
Morgan, Lewis & Bockius
2000 One Logan Square
Philadelphia, PA 19103-6993
(215) 963-5702/5667

Attorneys for Counterclaim
Defendants Fred L. Pirkle and
Therm-Omega-Tech, Inc.

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

CIVIL ACTIONS NO. 86-3374 and NO. 90-2430

OGONTZ CORPORATION,
Counterclaimant,

v.

FRED L. PIRKLE and THERM-OMEGA-TECH, INC.,
Counterclaim Defendants.

JURY VERDICT FORM

VERDICT

We find in favor of

Counterclaimant (Ogontz) _____

Counterclaim Defendants (Therm-Omega-Tech and Mr. Pirkle) _____

IF YOU HAVE FOUND IN FAVOR OF COUNTERCLAIM DEFENDANTS STOP HERE. IF YOU HAVE FOUND IN FAVOR OF COUNTERCLAIMANT, ANSWER THE FOLLOWING INTERROGATORIES AS APPROPRIATE.

INTERROGATORIES

1. Does the word "connected" as used in claims 1, 4, 9 and 10 of the '007 patent and claims 1 and 2 of the '512 patent mean "joined or linked together by an intervening element"?
   Yes _____ No _____

2. Does the word "connectable" as used in claim 1 of the '007 patent and claims 1 and 2 of the '512 patent mean "capable of being joined or linked or linked together by an intervening element"?
   Yes _____ No _____

3. Does the word "coupled" as used in claim 2 of the '512 patent mean "joined or linked together directly"?
   Yes _____ No _____

4. Does the word "attached" as used in claim 2 of the '007 patent mean "made fast as by tying or gluing"?
   Yes _____ No _____

5. Does the word "secured" as used in claims 4, 9 and 10 of the '007 patent mean "held fast"?
   Yes _____ No _____

6. Does the phrase "in contact with" as used in claims 1 and 2 of the '512 patent mean "touching"?
   Yes _____ No _____

7. Does the word "carried" as used in claim 1 of the '007 patent mean "borne"?
   Yes _____ No _____

8. Does the word "engaged" as used in claims 4 and 10 of the '007 patent mean "interlocked or meshed"?

Yes _____ No _____

9. Does the phrase "actuator element" as used in claims 4, 9 and 10 of the '007 patent mean "the piston"?

Yes _____ No _____

10. Does the phrase "temperature sensing element" as used in claims 1 and 3 of the '007 patent and claims 1 and 2 of the '512 mean "the actuator body"?

Yes _____ No _____

11. Does the phrase "heat conductive housing" as used in claim 1 of the '007 patent and claims 1 and 2 of the '512 patent mean "a housing with good heat conductivity"?

Yes _____ No _____

12. Does the word "through" as used in claims 4 and 10 of the '007 patent mean "extending from one surface to another"?

Yes _____ No _____

13. Does the word "controlling" as used in claims 2 of the '007 patent mean "slowing down"?

Yes _____ No _____

14. Does the phrase "to control" as used in claim 2 of the '512 patent mean "to slow down"?

Yes _____ No _____

15. Does the word "step" as used in claims 4 and 10 of the '007 patent mean "a steplike projection"?
Yes _____ No _____

16. Does any version of the Guru Plug have a "valve stem" or "stem means", as those terms are used in claims 1, 4, 9 and 10 of the '007 patent?
Yes _____ No _____

* * *

UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF PENNSYLVANIA

Civil Action Nos. 86-3374 and 90-2430

FRED L. PIRKLE and THERM-OMEGA-TECH, INC.

v.

OGONTZ CONTROLS COMPANY and THOMAS M. KENNY

COUNTERCLAIM DEFENDANTS' PROPOSED FINDINGS OF FACT AND CONCLUSIONS OF LAW IN CONNECTION WITH OGONTZ CORPORATION'S REQUEST FOR A PERMANENT INJUNCTION

[FILED MAY 11, 1994]

Counterclaim defendants respectfully submit the following proposed findings of fact and conclusions of law in connection with Ogontz Corporation's request for a permanent injunction:

Proposed Findings Of Fact

1. A person of ordinary skill in the art of designing and making locomotive freeze protection valves at the time of the '007 patent application would have understood the word "stem" as used in claims 4, 9 and 10 of the '007 patent to mean "the rod or spindle by which a valve is operated."

2. The inventor intended the word "connected" as used in claims 4, 9 and 10 of the '007 patent to mean "physically joined or linked together by an intervening element."

3. A person of ordinary skill in the art of designing and making locomotive freeze protection valves at the time of the '007 patent application would have understood the word "connected" as used in claims 4, 9 and 10 of the '007 patent to mean "physically joined or linked together by an intervening element."

4. The inventor intended the word "secured" as used in claims 4, 9 and 10 of the '007 patent to mean "held fast."

5. A person of ordinary skill in the art of designing and making locomotive freeze protection valves at the time of the '007 patent application would have understood the word "secured" as used in claims 4, 9 and 10 of the '007 patent to mean "held fast."

6. The inventor intended the word "with" as used in the phrase "moves with" in claims 4, 9 and 10 of the '007 patent to mean "at the same time, in the same direction, along the same axis and for the same distance."

7. A person of ordinary skill in the art of designing and making locomotive freeze protection valves at the time of the '007 patent application would have understood the word "with" as used in the phrase "moves with" in claims 4, 9 and 10 of the '007 patent to mean "at the same time, in the same direction, along the same axis and for the same distance."

8. The inventor intended the word "engaged" as used in claims 4, 9 and 10 of the '007 patent to mean "interlocked or meshed."

9. A person of ordinary skill in the art of designing and making locomotive freeze protection valves at the time of the '007 patent application would have understood the word "engaged" as used in claims 4 and 10 of the '007 patent to mean "interlocked or meshed."

10. The inventor intended the phrase "actuator element" as used in claims 4, 9 and 10 of the '007 patent to mean "the piston."

11. A person of ordinary skill in the art of designing and making locomotive freeze protection valves at the time of the '007 patent application would have understood the phrase "actuator element" as used in claims 4, 9 and 10 of the '007 patent to mean "the piston."

12. The inventor intended the word "through" as used in claims 4 and 10 of the '007 patent to mean "extending from one surface to another."

13. A person of ordinary skill in the art of designing and making locomotive freeze protection valves at the time of the '007 patent application would have understood the word "through" as used in claims 4 and 10 of the '007 patent to mean "extending from one surface to another."

14. The inventor intended the phrase "heat conductive housing" as used in claim 9 of the '007 patent to mean "a housing with good heat conductivity."

15. A person of ordinary skill in the art of designing and making locomotive freeze protection valves at the time of the '007 patent application would have understood the phrase "heat conductive housing" as used in claim 9 of the '007 patent to mean "a housing with good heat conductivity."

16. A person of ordinary skill in the art of designing and making locomotive freeze protection valves at the time of the '007 patent application would have understood the word "remote" as used in claim 9 of the '007 patent to mean "separated by great intervals."

17. The foregoing definitions as intended by the inventor and/or understood by one of ordinary skill in the art are consistent with the prosecution history, the specification, other claims and the drawings of the '007 patent and dictionary definitions.

* * *